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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,249	06/02/2000	Seishiro Yoshioka	35.C5745 CIP/C2/D2/REI	6842

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EXAMINER

RAMSEY, KENNETH J

ART UNIT PAPER NUMBER

2879

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,249

Applicant(s)

YOSHIOKA ET AL.

Examiner

Kenneth J. Ramsey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is ~~non-final~~.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed since applicant has made changes to the specification, claims or drawings subsequent to the date, March 13, 2002, of the most current reissue declaration in this application.

Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Recapture

The examiner has appended section MPEP 1412.02 to this Office action. Recapture is still applicable based upon this section of the MPEP which is deemed to follow the current case law as set forth therein.

Claims 58 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ

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289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

All of the patent claims were amended from their original form or distinguished from the prior art as set forth in either paragraph A or paragraph B, page 3 of the last office action:

A. Claim 141 was argued to be patentable over the patent to van Gorkom because "By contrast, in claims 141-143 of the present invention it is the fine particles between the electrodes that is the goal of the present invention. Whereas injected ions act as independent atoms [Gorkon et al, page 36, line 11], **the dispersed fine particles are bulky in nature** and do not act as individual atoms. This argument references the following language in claim 141: "**dispersing fine particles between said electrodes**".

B. Claims 137 and 144 were amended to overcome rejection thereof by the addition of the following language "**forming electrodes opposed to each on a substrate; forming between the electrodes an insulating layer in which fine particles are completely exposed; and etching the insulating layer so as to partially expose the fine particles**". Subsequently, the examiner required the

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applicant to add **"and in contact therewith"** to each claim after "between the electrodes".

Thus recapture is present since any claim that does not contain either the "A" limitations or the "B" limitations is broader in an aspect relating to the surrender of claim scope. An argument that certain subject matter was not claimed and therefore in the parent application and therefore could not have been surrendered misses the point. Such newly claimed matter can be claimed only if it does not impermissibly recapture the aspects that were surrendered. Applicants argue that their argument to distinguish Claim 141, merely distinguished the prior art process which dispersed ions into the emissive layer and thus only that prior art process was surrendered. Even if this was true since none of the claims preclude the dispersing of ions into the emissive layer applicant has recaptured surrendered subject matter. However, the test of surrendered subject matter involves which limitations of the claims were relied upon to distinguish applicants claims from the prior art, not what is taught in one or more of the prior art references. See e.g. *Pannu*, 258 F.3d 1366 at 1372, 59 USPQ 2d 1597.

"Pannu argued to the examiner, 'no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape.' The addition of the 'continuous, substantially circular arc' limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc." (underlining added)

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The court considered the claim limitation relied upon by the applicant to distinguish their claims from the prior art, not the content of the cited prior art, as defining the subject matter that was surrendered. Since the rejected claims do not contain either of the limitations that were relied upon to secure a patent, applicant has recaptured surrendered subject matter since the broadness (i.e., scope) of those claims extends into the domain that was surrendered in order to obtain a patent. The only possible issue is whether or not the recapture is permissible (test 3 under *Pannu* 258 F.3d 1366).

Applicants argue that the recapture is permissible per the case law, e.g. *Pannu*, 258 F.3d at 1372 and *Hester* 142 F.3d at 1482-1483. The examiner agrees with the case of *Hester* that where claims are broadened in aspects related to the surrendered subject matter but are materially narrowed in other overlooked aspects of the invention, that the recapture rule can be avoided. See *Hester* 46 USPQ2d 1641 at 1650:

"The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. [5] However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the 'spiral conveyance path' and 'high humidity steam' limitations. The term 'high humidity steam' is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term 'high humidity steam' is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere 'at near 100% humidity 100 degrees C. and a pressure above atmospheric.' '047 patent, col. 6, ll. 3-4. Hester concedes that the term 'high humidity steam' is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of 'high humidity steam.' Accordingly, the use of the term 'high humidity steam' does not save the reissue claims from the recapture rule. "

The examiner agrees that the limitations "Pd", "carbon", "SiO₂", relating to the specific material of the dispersed layer of patent claim 3, and the limitation (step like structure" relating to the shape of the dispersed layer of patent claim 3 as found in each of the allowed claims are material features of the claimed invention relating to the surrendered subject matter that were overlooked by applicants. These limitations serve to avoid the recapture rule. Thus the claims that recite these features have been

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Appendix

1412.02 Recapture of Canceled Subject Matter

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

TWO STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor [Mentor Corp. v. Coloplast, Inc.]*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993), courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A

reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim."

Where a claim in a reissue application is in fact broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination.

CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. See MPEP § 706.02(l)(1) with respect to amendments made to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made. The examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. The record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered.

Example

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(A) A limitation of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general "boiler plate" sentence will not be sufficient to establish recapture. An example of one such "boiler plate" sentence is:

In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.

This type of general "argument" will not, by itself, be sufficient to establish surrender and recapture.

Example

(B) The limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter.

Example

(C) The limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

ARGUMENT (WITHOUT AMENDMENT TO THE CLAIMS) IN THE ORIGINAL APPLICATION MAY BE SUFFICIENT TO ESTABLISH RECAPTURE:

In *Clement*, the recapture was directed to subject matter surrendered in the original application by changes made to the claims (i.e., amendment of the claims) in an effort to overcome a prior art rejection. The *Clement* Court, however, also stated that "[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." [Emphasis added] 131 F.3d at 1469, 45 USPQ2d at 1164. This statement in *Clement* was subsequently discussed in *Hester Indus., Inc. v. Stein, Inc.*, *supra*, where the Court observed that surrender of claimed subject matter may occur by arguments made during the prosecution of the original patent application even where there was no claim change made. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone." 142 F.3d at 1482, 46 USPQ2d at 1649. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution

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history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

REISSUE CLAIMS HAVE SAME OR BROADER SCOPE IN ALL ASPECTS:

The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent. Ball, 729 F.2d at 1436, 221 USPQ at 295.

REISSUE CLAIMS ARE NARROWER IN SCOPE IN ALL ASPECTS:

The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims canceled from the original application to obtain a patent. If the reissue claims are narrower than the claims canceled from the original application, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent. Ball, 729 F.2d at 1436, 221 USPQ at 295. See MPEP § 1412.03 as to broadening claims.

REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:

Reissue claims that are broader in certain aspects and narrower in others vis- à-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." Clement, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). This is not to be considered a recapture. The addition of process claims, however, will generally be considered to be a broadening of the invention (Ex parte Wikdahl, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a broadening of the invention (Ex parte Wikdahl, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such

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addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

Action Made Final

1. Applicants' amendments to the claims necessitated the new grounds of rejection herein. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Directions for Responses

Any formal response to this communication should be directed to examiner Kenneth Ramsey, Art Unit 2879, and either

faxed to: 703-872-9319; or mailed to: Box AF

Assistant Commissioner For Patents
Washington, D.C. 20231

Technical inquiries concerning this communication should be directed to Kenneth J. Ramsey, (703) 308-2324 (voice), (703) 746-4832 (fax).



Kenneth J. Ramsey
Primary Examiner
Art Unit 2879